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Panu K. Zoller

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3M INNOVATIVE PROPERTIES COMPANY

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EXAMINER

CHANG, VICTOR S

ART UNIT

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PANU K. ZOLLER and EUGENE G. HENNEN

Appeal 2010-008798
Reissue Application 10/817,439
Patent 6,365,254
Technology Center 1700

Before BRADLEY R. GARRIS, KAREN M. HASTINGS, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

This is in response to a Request for Rehearing (“Request”), dated December 14, 2010, of our Decision, mailed October 20, 2010 (“Decision”), wherein we affirmed the Examiner’s § 103 rejections of all appealed claims.

We have reconsidered our Decision of October 20, 2010, in light of Appellants’ comments in the Request for Rehearing, and we find no error in the disposition of the § 103 rejections.

We have thoroughly reviewed the arguments set forth by Appellants in the Request. However, we remain of the opinion that the subject matter of claims 1-53 and 55 is properly rejected and unpatentable under 35 U.S.C. § 103(a).

Appellants argue that the decision reached by the merits panel is in error because “the Board’s reliance” on the Examiner’s finding that it is self-evident that Johnson suggests that a tackifier is a friction enhancing agent “clearly establishes that the rejection . . . relies solely on conclusory statements” which is “contrary to Supreme Court precedent as set forth in *KSR*” (Request 2, 4). Appellants also argue that our reliance on the purported equivalency of EAA and EVA is “contrary to . . . *In re Ruff*” (Request 2-3, 5), and that our decision regarding the purported amounts of vinyl acetate is “contrary to . . . *In re Antonie*” (Request 3, 6).

We do not find Appellants’ contentions persuasive of error in our Decision. First, the Examiner provided ample reasoning based on the teachings of the Johnson reference to support his finding that a tackifier is a friction enhancing agent. Indeed, the functional name of “tackifier” *per se* connotes a friction enhancing agent. Notably, Appellants did not dispute that finding of the Examiner (*see*, Decision 5). In these situations, an Appellant’s “[s]ilence implies assent.” *Harper & Row Publishers Inc. v.*

Nation Enters., 471 U.S. 539, 572 (1985). *See also, e.g., In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970) (where appellant has had the opportunity and failed to challenge a finding, such finding is considered to be conclusive).

Furthermore, as stated on pages 4-5 of the Decision, the Examiner found that Johnson 924 suggests that one of its listed release materials may be modified by a tackifier to provide a roll stability layer as needed. The Examiner also found that Johnson 924 describes other release materials that may be used.² The Examiner reasonably concluded, based on the teachings of Johnson 924, that a person of ordinary skill in the art would have reasonably expected that adding a tackifier to another known suitable release layer material applied in a known adhesive tape assembly would have resulted in a roll stability layer as claimed.

Finally, Appellants argue that our decision regarding the purported amounts of vinyl acetate is “contrary to . . . *In re Antonie*” (Request 3, 6) since there is no evidence to establish that the amount of vinyl acetate is a result effective variable.

We disagree. As noted on page 6 of our Decision, claims 10 and 45 merely functionally recite the vinyl acetate content is such “that the roll stability layer does not block with said heat activated layer”. Appellants do not dispute that the artisan would have understood that it would have been undesirable for the EVA release material to block with the heat activated adhesive layer (Decision 6; *see generally* Request).

As stated on page 6 of the Decision,

² It is well settled that obviousness can be predicated on a teaching of art-recognized equivalence, *In re Ruff*, 256 F.2d 590, 594 (CCPA 1958), even in the absence of an express suggestion to make the substitution, *In re Fout*, 675 F.2d 297, 301-02 (CCPA 1982).

it would have been understood by one of ordinary skill in the art that it would have been undesirable for the EVA release material to block with the heat activated layer of Johnson 924. Consequently, we agree with the Examiner that “selecting a workable vinyl acetate content in EVA” would have been within the level of skill in the art (Ans. 10; *see also* Ans. 6).

In conclusion, based on the foregoing, Appellants’ Request is granted to the extent that we have reconsidered our Decision, but is denied with respect to making changes to the disposition therein.

This Decision on the Request for Rehearing incorporates our Decision, mailed October 20, 2010, and is final for the purposes of judicial review. See 37 CFR 41.52 (a)(1).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v)(2010).

DENIED

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